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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/814,253 | 04/01/2004 | Julio A. Abusleme | 108910-00129 | 6955 |

4372 7590 06/08/2007
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| EXAMINER |
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ZEMEL, IRINA SOPJIA

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| ART UNIT | PAPER NUMBER |
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1711

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| MAIL DATE | DELIVERY MODE |
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06/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/814,253 | Applicant(s) ABUSLEME ET AL. | |
| | Examiner Irina S. Zemel | Art Unit 1711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7 and 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 7, 10-16 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable US Patent publication 20010003124 to Zolotnitsky et al., (hereinafter "Zolotnitsky").

The rejection stands as per reason of record previously stated as applicable to claims 6 and 8.

As previously discussed, the reference expressly discloses 90 mole % of CTFE in [0024], and further expressly discloses up to 15 % of fillers such as PTFE. The applicants arguments that the reference excludes 90 mole % of CFTE in the copolymer are not convincing as such amount is expressly disclosed in the reference. Thus, choosing all the claimed ratios and amounts from expressly disclosed ranges would have been obvious in the absence of unexpected results that can be attributed to the claimed numerical limitations.

The invention as claimed thus, would have been clearly obvious from the disclosure of the Zolotnitsky reference.

Claim Rejections - 35 USC § 103

Claims 1-5, 7, 10-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zolotnitsky in combination with US Patent 6,107,393 to Abusleme et al., (of record, hereinafter "Abusleme '393").

The rejection stands as per reason of record. Assuming, *arguendo* and for the sake of the record clarity, that the applicants are correct in their assertion (which the examiner does NOT believe they are), that the reference excludes the expressly disclosed upper limitation of 90 mole % of CTFE in the copolymer, the claimed amounts of CTFE in the copolymer would have been obvious as per discussion in the previous non-final office action stating with regard to claim 17. The Office action states that "As far as the limitations of claims 17, the reference does not disclosed amounts of CTFE higher than 90 mole %, but discloses that the properties of the resulting copolymers vary with varying the amounts of respective co-monomers. Thus, the amounts of respective comonomers are considered to be result effective variable ultimately governing the properties of the final product, and, as such, optimization of the result effective variable would have been obvious for an ordinary artisan to obtain the desired end result." This position is further supported by the disclosure of, for example, by examples of Abusleme '393 as the evidence of varying properties depending on the monomer composition in the copolymers.

The invention as claimed, thus, is would have been clearly obvious from the disclosure of the Zolotnitsky reference as supported by Abusleme '393.

Response to Arguments

Applicant's arguments filed 3-14-2007 have been fully considered but they are not persuasive. The applicants, once again, argue that the Zolotnitsky reference discloses a CTFE copolymer where ethylene is always present, and in contrast, the

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claimed invention is directed to copolymers that have a comonomer different from ethylene. And once again the examiner points out that she agrees that the Zolotnitsky reference requires the presence of ethylene, but disagrees that the copolymer as **claimed** in the instant application excludes the presence of ethylene as a comonomer. In fact, the claimed copolymer is open to the presence of ANY third comonomer, including ethylene as the copolymer is claimed via an "open language" phrase "containing".

The applicants further argue that the disclosed molar comonomer amounts, i.e., 10-70 of (a) ethylene, 30-90 of (b) CTFE and 0.1 to 30 of comonomer (c), exclude the upper disclosed amount of component (b) of 90 molar % as the components (a) and (c) must be present in at least the amounts of 1.1. This is not convincing as the applicants interpret the disclosure so that it fits their arguments of excluding the disclosed 90 mole % of the CTFE comonomer. By the same logic advanced by the applicants, why is it that the component (a), i.e., ethylene **must** be present in the amounts of **at least** 10 % (note that the reference does not state that the amounts of (a) is *AT LEAST* 10%), when the upper expressly disclosed amount of (b) is 90 and the lower amount of (c) is 0.1? The second interpretation, equally applicable is that the amount of ethylene must be lowered when 90 of CTFE is present. There is no evidence on the record whatsoever that the applicants of the references PGPub intended to expressly include "at least" 10 % of (a) and exclude expressly disclosed amounts of (c) of 90%. The disclosure implies, by disclosing amounts of (a) as 70 and (b) as 90, that variations of the comonomer amounts, (and not necessarily in favor of applicants interpretation of the disclosure) are

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possible and are within the inventive concept disclosed . Even if the applicants' interpretation is correct, the expressly disclosed amounts of CTFE would be 89.9 mole % as compared to the claimed 90 mole %. The obviousness of varying the CTFE amount by .1 % is discussed above and is considered to have been obvious.

Th applicants further argue that the technical problem of the presently claimed invention is to find CTFE-based polymer compositions that are "easy to be prepared and easy to be transformed into foamed coatings or articles" without requiring foaming agents other than the nucleating agent of component B". While this may be so, the patentability of a composition, according to US practice, is based on what the composition is, and not what technical problem is solved. The composition as claimed is a two component composition containing a copolymer and a second component, namely a nucleating agent (specified in claim 4 as PTFE). Such compositions are, again, would have been clearly obvious from the disclosure of Zolotnitsky (alone or in combination with the secondary reference.). Once again, whether Zolotnitsky recognized the technical problem solved by the applicants or whether the Zolotnitsky reference named the identical compound (Polymist), the same name as the applicant, i.e., nucleating agent, is irrelevant, as irrelevant is the presence of additional components in the compositions of Zolotnitsky, unless clearly shown that the compositions of Zolotnitsky are INCAPABLE of being foamed or the foams obtained from compositions of Zolotnitsky have so different properties that the claimed foam (and that would be only applicable to the foam claims, not the foamable composition claims) properties are unexpected.

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All other arguments regarding preferred embodiments and intended use have been previously addressed in multiple office actions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Irina S. Zemel
Primary Examiner
Art Unit 1711



ISZ